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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,079	04/21/2005	Jacek Marczyk	JACCSE	6206
7590 Pisner & Pisner, Attorney 12111 Fairfax Hunt Road Fairfax, VA 22030		05/09/2008	EXAMINER STARKS, WILBERT L	
			ART UNIT 2129	PAPER NUMBER
			MAIL DATE 05/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of:)	
Jacek Marczyk)	DECISION ON PETITION
Application No. 10/532,079)	UNDER 37 CFR 1.181 TO
Filed: April 21, 2005)	INVOKE SUPERVISORY
For: PROCESS FOR THE CREATION OF)	REVIEW
FUZZY COGNITIVE MAPS FROM		
MONTE CARLO SIMULATION		
GENERATED META MODEL		

This is a decision on the petition, filed April 11, 2007 under 37 CFR 1.181 to require the Examiner to withdraw the final Office action mailed on March 7, 2007. Although not specifically stated in the petition, the petition is treated as a petition under 1.181(a) to invoke Supervisory Authority and require the Examiner to withdraw the final Office action.

RECENT PROSECUTION BACKGROUND

- | | |
|-------------------|---|
| June 27, 2006 | - Non-final Office action mailed. Examiner entered the following rejections:
(1) claims 1-6 under 35 USC 112, first paragraph as failing to enable one of ordinary skill in the art how to use the claimed invention and
(2) claims 1-6 under 35 USC 101, as being directed to nonstatutory subject matter. |
| November 27, 2005 | -Petitioner files response canceling claims 1-6, adding new claims 7-13 and presenting arguments to traverse the rejections under 35 USC 112 1 st paragraph and 35 USC 101. |
| March 7, 2007 | - Final rejection mailed. Examiner enters the following rejections:
(1) claims 7-13 under 35 USC 112, first paragraph as failing to enable one of ordinary skill in the art how to use the claimed invention and
(2) claims 7-13 under 35 USC 101, as being directed to nonstatutory subject matter. |
| April 11, 2007 | - Petition filed under 37 C.F. R. 1.181(a). |

- September 11, 2007 - Petitioner filed a response after final, with proposed amendment cancelling claims 7-13 and adding new claims 14 – 46.
- February 5, 2008 - Examiner issued an Advisory action denying entry of the proposed amendment and maintaining all rejections made in the final action.

RELIEF REQUESTED

Petitioner filed the instant petition on April 11, 2007 contending that the final rejection issued by the Examiner is not complete. Although not clearly stated in the petition, Applicant appears to argue that at least one document that was incorporated by reference in the instant specification, namely the book "Principles of Simulation-Based Computer-Aided Engineering" was not considered before issuing the first Office action mailed June 27, 2006 therefore, the Non-final action was incomplete, and since examiner maintained all grounds of rejection in the final Office action, the final action is incomplete as well.

Specifically, petitioner lists under the "Discussion of the Applicable Law" section of the petition (page 5) the following outstanding issues:

- (i) There was and still is the issue, raised by Examiner, of some of the claims being incorrectly assigned to Art unit 2129; this issue was raised by Examiner during the January 4, 2007 interview and in Examiner's January 30, 2007 E-mail to Applicant.
- (ii) There was and still is the issue of the proposed claims that were sent to Examiner on January 30, 2007; claims that the Examiner agreed to review, but had either failed to review or had failed to notify Applicant of the results of his review.

Note: Applicant is referring to the draft revised claims submitted on January 30 via facsimile after a telephone interview between the examiner and Gary Pisner, Attorney for Applicant on January 4, 2007 (see Exhibit F submitted in support of the petition, where draft claims 7-39 were presented for Examiner's review).

- (iii) There was and still is the issue of which of the claims submitted on January 30, 2007, would be allowable. Given that Examiner had indicated, in his January 30, 2007 communication to Applicant, that (referring to the claims) "Some [claims] look statutory". Given that there was no prior art, Examiner, in his January 30, 2007 communication, is stating that some of the claims "look allowable," yet because Examiner did not respond, as he agreed to, Applicant does not have any idea which of the claims are allowable, especially because Examiner, in his Final Office Action, only addressed those claims that were submitted on November 27, 2006 - prior to any interview and prior to the resolution of the issues arising from Examiner's incomplete review of the application during his preparation of his first office action.

Petitioner further asserts the following:

With pending actions by the Examiner unfulfilled and their accompanying issues still unresolved, the issuance of a final Office action was premature.

Petitioner requests reversal of the Examiner's decision to issue his Final Office Action.

ANALYSIS

The relevant section of the MPEP concerning finality of Office practice is MPEP § 706.07

In the language of the MPEP:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated.

The question to be addressed is whether the Examiner responded to the substance of Applicant's traversal.

A review of the record reveals that in response to the rejection of claims 1-6 made in the non-final action, and specifically in response to the rejection of claims 1-6 under 112 first paragraph as lacking a description of practical application of the claimed invention, Applicant has canceled claims 1-6, added new claims 7-13, and has pointed out where the practical application for the invention recited in each of claims 7-13 is disclosed. Specifically, Applicant pointed out particular sections within documents incorporated by reference into the specification of the Provisional Application from which the instant application claims priority.

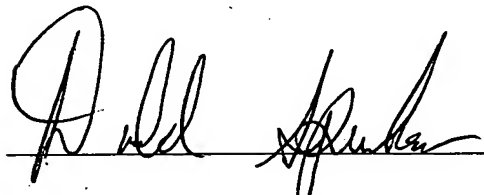
In response, Examiner has not specifically addressed Applicant's contention that the subject matter recited in new claims 7-13 is adequately described in the specification, therefore meeting the written description and enablement requirement of 35 USC 112 first paragraph. A careful review of the final action reveals that Examiner's rejection of claims 7-13 under 35 USC 112 first paragraph made in the final Office action and explanation in support thereof in response to Applicant's arguments do not meet the requirements set forth in MPEP 2163.04 (Burden on the Examiner with Regard to the Written Description Requirement) and MPEP 2164.04 (Burden on the Examiner Under the Enablement Requirement) and MPEP 2164.05 (Determination of Enablement Based on Evidence as a Whole). In particular, Examiner has not provided any explanation why the instant Specification does not meet the written description requirements of 35 USC 112, first paragraph for the subject matter recited in claims 7-13, when the two documents incorporated by reference in the Provisional Application are taken into consideration.

Since Examiner has not fully met the burden with regard to the rejection of claims 7-13 under 35 USC 112, first paragraph, and has not fully addressed Applicant's arguments presented in the response filed November 27, 2005 the final action mailed March 7, 2007 is incomplete. Accordingly the petition to withdraw the final Office action is **GRANTED**.

The final Office action of March 7, 2007, is **VACATED**.

Further, in view of the above decision, the Advisory action mailed February 5, 2008 is hereby vacated and the proposed amendment cancelling claims 7-13 and adding new claims 14 – 46 has been entered.

The application is being forwarded to Examiner for issuing a new Office action based on the examination of newly added claims 14 -46.



Donald Sparks, Acting Director

Technology Center 2100